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David A. Jarus

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POLYONE CORPORATION
33587 WALKER ROAD
AVON LAKE, OH 44012

EXAMINER

NILAND, PATRICK DENNIS

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/595,282
Filing Date: April 04, 2006
Appellant(s): JARUS ET AL.

John Hornickel and Richard Anderson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/13/08 appealing from the Office action mailed 7/12/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0156171

DREWNIAK et al.

10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

I. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. There is not basis in the originally filed specification for the newly recited range of “at least about 8 weight percent”. Particularly, there is not basis for the newly recited endpoint of “about 8 weight percent”. The appellant’s argued basis is noted but does not support the claimed language.

II. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. Application Publication No. 2002/0156171 A1 Drewniak et al..

Drewniak discloses the instantly claimed compounds, articles, and methods at the abstract; sections [0002], [0008], [0015]-[0024], which encompasses the instantly claimed amounts of ingredients of claims 1, 4, 8, 14, and 16 and the modified polyolefin falls within the scope of the instantly claimed “compatibilizing dispersion agent” since it performs that function, [0025]-[0026], [0034]-[0042], [0043]-[0045], which encompasses the instantly claimed nanoclays, [0048]-[0065], which encompasses the instantly claimed method steps of claims 5, 10, and 11 and sections [0048]-[0049], [0051]-[0052] further encompass the instantly claimed amounts, [0053] encompasses the additives of the instant claims 3, 12, and 13, [0077], [0087], [0089], [0090], of which the examples use amounts falling within the scope of the instant claims, [0092], [0093], [0095], of which the examples use amounts falling within the scope of the instant claims, [0097] of which the polyethylene octene falls within the scope of the elastomer of the instant

claims 2 and 17, [0098]-[0114], the claims, and the remainder of the document. Pellets of the instant claim 9 are disclosed at section [0064].

The reference is not limited to its examples. There is not basis for the appellant's argument that the reference must prove each of its disclosed embodiments works and not basis is seen to suspect that the upper range of clay, e.g. 10% with the lower range of functionalized polyolefin, e.g. 2% up to the amount that gives greater than 3.1:1, e.g. 3.226%. See sections [0023]-[0024] and the other sections cited above. Given the upper range of clay useful according to the reference, 10% seems rather low as does 3.1% where only 1% of the functionalized polyolefin is used. The appellant's representatives statements that making a 102 and 103 rejection is evidence of a deficiency in the 102 rejection is not persuasive. Anticipation is considered the ultimate in obviousness such that it is always permissible to make the 103 no matter how good the 102 rejection is and it is permissible in the law to give alternative theories of a situation without any alternative being taken as proving the other alternatives incorrect. Furthermore, it is opinion as to how much choosing can be done from a references teachings until it is no longer a 102 reference. Thus, the examiner always makes the 102 and 103.

III. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Application Publication No. 2002/0156171 A1 Drewniak et al..

Drewniak discloses the instantly claimed compounds, articles, and methods at the abstract; sections [0002], [0008], [0015]-[0024], which encompasses the instantly claimed amounts of ingredients of claims 1, 4, 8, 14, and 16 and the modified polyolefin falls within the scope of the instantly claimed "compatibilizing dispersion agent" since it performs that function, [0025]-[0026], [0034]-[0042], [0043]-[0045], which encompasses the instantly claimed nanoclays,

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[0048]-[0065], which encompasses the instantly claimed method steps of claims 5, 10, and 11 and sections [0048]-[0049], [0051]-[0052] further encompass the instantly claimed amounts, [0053] encompasses the additives of the instant claims 3, 12, and 13, [0077], [0087], [0089], [0090], of which the examples use amounts falling within the scope of the instant claims, [0092], [0093], [0095], of which the examples use amounts falling within the scope of the instant claims, [0097] of which the polyethylene octene falls within the scope of the elastomer of the instant claims 2 and 17, [0098]-[0114], the claims, and the remainder of the document. Pellets of the instant claim 9 are disclosed at section [0064].

It would have at least been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed ingredient combinations, amounts thereof, and processing steps in making the final articles because they are encompassed by the reference and would have been expected to give the properties and results disclosed by the reference.

The reference is not limited to its examples. There is not basis for the appellant's argument that the reference must prove each of its disclosed embodiments works and not basis is seen to suspect that the upper range of clay, e.g. 10% with the lower range of functionalized polyolefin, e.g. 2% up to the amount that gives greater than 3.1:1, e.g. 3.226%. See sections [0023]-[0024] and the other sections cited above. Given the upper range of clay useful according to the reference, 10% seems rather low as does 3.1% where only 1% of the functionalized polyolefin is used. There is no showing of unexpected results commensurate in scope with the teachings of the cited prior art and the instant claims.

(10) Response to Argument

I. In response to paragraph (9)I above:

The appellant's argument that their examples that demonstrate 8% of nanoclay and 12 % nanoclay provide sufficient basis for "about 8 weight percent". The examples are limited to specific mixtures of components that do describe enable "about 8 weight percent" for the entire scope of the instant claims. Particularly there is no basis to enable "about". The ratio of nanoclay to compatibilizing dispersion agent" was not rejected and does not provide description for "about 8 weight percent", particularly "about". The appellant's argument regarding "at least" is also not seen as providing basis for "about 8 weight percent" particularly "about". For these reasons and those stated in the above rejection, this rejection should be affirmed.

II. In response to paragraph (9)II above:

Appellant's arguments of what is required in an anticipation rejection are noted and these elements are met by the above cited reference, particularly at the sections cited in the rejection. These cited sections describe the instantly claimed invention with sufficient specificity so that the ordinary skilled artisan would practice the instantly claimed invention from the disclosure of Drewniak et al.. Particularly, one of ordinary skill in the art choosing the lower endpoint of the "functionalized polyolefin" of Drewniak, which falls within the scope of the instantly claimed "compatibilizing dispersion agent", and the upper endpoint of the nanoclay of section [0024] and the related sections would simultaneously meet both the instantly claimed weight ratio of compatibilizing dispersion agent to nanoclay and the amount of nanoclay. With regard to section [0024], the appellant argues that this section is not any better than section [0015]. The appellant does not specifically address the specificity of section [0024]. There arguments therefore do not particularly point out and distinctly show the examiner's reliance on this disclosure of the reference to be incorrect in the anticipation rejection. The appellant argues

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that the example of Drewniak do not show a successful blending of more than 2:1 clay to dispersant. The reference is not limited to its examples. Again, section [0024] is noted. The appellant argues that Drewniak can not be considered a valid reference for anything other than it has proven to work. This is inconsistent with the patent law on this issue and the appellant has provided no probative evidence that the full scope of section [0024] and the other sections relied on in the above rejection will not work. For these reasons and those stated in the above rejection, this rejection should be affirmed.

III. In response to paragraph (9)III above:

The arguments of paragraph (10) are repeated herein. In addition, the appellant has provided no showing of unexpected results, commensurate in scope with the instant claims and the cited prior art, stemming from any differences between the cited prior art and the instant claims. The examiner notes that the examples of the appellant are not commensurate regarding numerous limitations which materially affect the composition properties including but not limited to amounts of ingredients, molecular weights and polydispersities of the polymers used, identities of the nanoclays, reaction conditions in combining the components, additives encompassed by “comprising”, nature of the matrix polymer, degrees of branching of the polymers, identity of the compatibilizing dispersion agent, etc. Appellant’s reference to comparison of nanocomposite TPO to neat TPO is not commensurate with Drewniak which actually uses thermoplastic matrix polymer, nanoclay, and compatibilizing dispersion agent, not just neat TPO. The appellant has provided no evidence that the reference statement regarding using “about 1 to 100 percent by weight of functionalized polyolefin, and from about 10-50 weight percent modified clay is “absurd”, as argued by the appellant. Appellant addresses

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section [0018] of Drewniak in their arguments to the 103 rejection above but again does not specifically address other portions of Drewniak cited including section [0024]. The appellant's arguments are therefore not commensurate in scope with the full disclosure of the reference.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Patrick Niland/
Primary Examiner
GAU 1796

Conferees:

/David Wu/
Supervisory Patent Examiner, Art Unit 1796

David Wu
SPE 1796

Greg Mills
TQAS 1700

/Gregory L Mills/
Supervisory Patent Examiner, Art Unit 1700